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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/489,937	01/24/2000	Koji Nakagiri	862.C1801	6485
5514	7590	10/27/2005	EXAMINER	
FITZPATRICK CELLA HARPER & SCINTO 30 ROCKEFELLER PLAZA NEW YORK, NY 10112			BASHORE, WILLIAM L	
			ART UNIT	PAPER NUMBER
			2176	
DATE MAILED: 10/27/2005				

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/489,937	Applicant(s) NAKAGIRI ET AL.	
	Examiner William L. Bashore	Art Unit 2176	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 18 August 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-37 is/are pending in the application.
 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-37 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This action is responsive to communications: RCE and amendment filed 8/18/2005, to the original application filed 1/24/2000, with priority filing date of 1/28/1999.
2. Please note that two independent sets of rejections are applied to the pending claims.
3. Claims 1-37 pending. Claims 1, 8, 15, 22, 29, 30, 31, 36, 37 are independent claims.

Continued Examination Under 37 CFR 1.114

4. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 7/15/2005, and 8/18/2005, has been entered.

Specification

5. **The amendment filed 7/15/2005 is objected to under 35 U.S.C. 132(a) because it introduces new matter into the disclosure.** 35 U.S.C. 132(a) states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows: all of the additions and deletions set forth in Applicant's amendment to the Specification (pages 2-5) filed 7/15/2005.

Applicant is required to cancel the new matter (as well as reapply matter that was deleted since deletion of matter is considered new matter (i.e. "*intermediate data format...*", etc.)) in the reply to this Office Action.

Claim Rejections - 35 USC § 112

6. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

7. Claims 1, 8, 15, 22, 29, 30, 31, 36, 37 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. In particular, Applicant's claimed amendment regarding "*wherein the changing means changes the size of the output image data before said transmitting means starts to communicate with the receiving apparatus*" is based upon new matter as explained above, therefore said amendment is not enabled by Applicant's specification.

8. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

9. Claims 1, 8, 15, 22, 29, 30, 31, 36, 37 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The limitation: "*wherein the changing means changes the size of the output image data before said transmitting means starts to communicate with the receiving apparatus*" is vague and indefinite. Since said amendment is non-enabling new matter, the examiner cannot determine with certainty the scope and definition of said limitation.

Examiner's Note

10. It is noted that two independent sets of rejections apply to the instant claims under separate interpretations. Regarding representative claim 1, the first rejection set (beginning at paragraph 11) is directed towards the interpretation of a “*changing means...*”, as originating internally, while the second rejection set (beginning at paragraph 15) is directed towards said “*changing means...*” as originating externally (i.e. from another computer).

It is also noted that the following rejections are applied based upon a possible interpretation of “*wherein the changing means changes the size of the output image data before said transmitting means starts to communicate with the receiving apparatus*” as directed to processing before beginning of communication.

Claim Rejections - 35 USC § 102

11 **The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:**

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

12. **Claims 1-33, 36-37 are rejected under 35 U.S.C. 102(b) as being anticipated by Schmid et al. (hereinafter Schmid), U.S. Patent No. 5,659,164 issued August 1997.**

In regard to independent claim 1, Schmid discloses an electronic facsimile method comprising scanning a document, and electronically transmitting said document along with page specific information, said document and page information temporarily (inherently) stored in memory in an intermediate format (i.e. digital data stored in RAM memory) prior to, and during transmission of information (Schmid Abstract, column 2 lines

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4-23, 27-33, 40-45, 57-61, column 4 lines 57-67; compare with claim 1 “*An information processing system.....said system comprising:*”, and “*temporary storing means for temporarily storing, on a storage medium, output image data composed of a plurality of pages as well as output configuring information;*”).

Schmid discloses storing page size information on a cover page of a document, said information used for ascertaining final page size (Schmid column 4 lines 57-67, Figure 4; compare with claim 1 “*acquisition means for acquiring output size of a prescribed page....by said temporary storing means;*”).

Schmid discloses changing the size of each page based upon the output size. Schmid's cover sheet page size information is recognized, then used for adjusting scanner parameters for the rest of the pages accordingly (Schmid Figure 3B item 22, 23, column 4 lines 55-65; compare with claim 1 “*changing means for controlling the size of each page of the output image data based upon the output size acquired by said acquisition means such that all the pages coincide in size with the output size of the prescribed page.*”).

Schmid discloses changing page size of a scanned document accordingly (see above). Since it is well established that scanner/computer/FAX combinations typically comprise the capability of both sending and receiving Fax documents, it is well within reason that a user of Schmid's invention can Fax an already processed (i.e. size altered) electronic document to another receiving computer apparatus. Schmid also teaches network address/destination routing ID (Schmid Abstract, Figure 1, column 4 lines 22-28; compare with claim 1 “*transmitting means for...by said changing means.*”).

In reference to the preceding paragraph, Since Schmid acquires initial information from a cover page, FAXing an already processed document to a conventional receiving computer results in said receiving computer ignoring the special information on said cover page, therefore receiving the electronic document pages as is, with output image data processed before the document is FAXed (compare with claim 1 “*wherein said changing means changes the size of the output image data before said transmitting means starts to communicate with the receiving apparatus.*”).

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In regard to dependent claim 2, Schmid discloses page size information embedded on a cover page (a leading page of a fax document (Schmid column 4 lines 57-67)).

In regard to dependent claims 3, 4, Schmid discloses changing the size of each page based upon the output size. Schmid's cover sheet page size information is recognized, then used for adjusting scanner parameters for the rest of the pages accordingly (Schmid Figure 3B item 22, 23, column 4 lines 55-65).

In regard to dependent claims 5, 6, Schmid discloses enlarging/reducing output page sizes, based upon analysis of Schmid's cover sheet information. Since a cover sheet is typically part of a transmitted FAX document, and since page size modifications apply to a faxed document, said cover sheet is also changed accordingly (see also Schmid column 4 lines 57-67) (compare with claims 5, 6).

In regard to dependent claim 7, Schmid discloses a fax transmission (Schmid column 2 lines 27-34, especially lines 40-44).

In regard to claims 8-14, claims 8-14 reflect the apparatus comprising computer executable instructions used for implementing the system as claimed in claims 1-7, respectively, and are rejected along the same rationale.

In regard to claims 15-21, claims 15-21 reflect the computer executable methods comprising computer executable instructions used for implementing the system as claimed in claims 1-7, respectively, and are rejected along the same rationale.

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In regard to claims 22-28, claims 22-28 reflect the computer executable methods comprising computer executable instructions used for implementing the system as claimed in claims 1-7, respectively, and are rejected along the same rationale.

In regard to independent claim 29, claim 29 reflects the computer program product comprising computer executable instructions used for implementing the system as claimed in claim 1, and is rejected along the same rationale.

In regard to independent claim 30, claim 30 reflects the computer program product comprising computer executable instructions used for implementing the system as claimed in claim 1, and is rejected along the same rationale.

In regard to independent claim 31, claim 31 reflects the apparatus comprising computer executable instructions used for implementing the system as claimed in claim 1, and in further view of the following, is rejected along the same rationale.

Schmid teaches page size information embedded on a cover page (a leading page of a fax document (Schmid column 4 lines 57-67; compare with claim 31 *“to attach cover page information”*)).

In regard to dependent claim 32, claim 32 reflects the apparatus comprising computer executable instructions used for implementing the system as claimed in claim 7, and is rejected along the same rationale (see also Schmid Figure 1, 2A – scanned and OCR’d images of page documents).

In regard to dependent claim 33, claim 33 reflects the apparatus comprising computer executable instructions used for implementing the system as claimed in claim 2, and is rejected along the same rationale.

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In regard to independent claim 36, claim 36 reflects the computer executable method comprising computer executable instructions used for implementing the system as claimed in claim 1, and in further view of the following, is rejected along the same rationale.

Schmid discloses page size information embedded on a cover page (a leading page of a fax document (Schmid column 4 lines 57-67; compare with claim 36 “*generating cover page information*”).

In regard to independent claim 37, claim 37 reflects the computer program product comprising computer executable instructions used for implementing the system as claimed in claim 1, and in further view of the following, is rejected along the same rationale.

Schmid discloses page size information embedded on a cover page (a leading page of a fax document (Schmid column 4 lines 57-67; compare with claim 37 “*generating cover page information*”).

Claim Rejections - 35 USC § 103

13. **The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:**

title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a w(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this hole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

14. **Claims 34-35 are rejected under 35 U.S.C. 103(a) as being unpatentable over Schmid.**

In regard to dependent claims 34, 35, Schmid does not specifically disclose template information associated with cover page information. However, Schmid teaches an “MRI” comprising a set display of page information, which provides reasonable suggestion to the skilled artisan of an information template, the size of

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said cover page (with attached MRI) to be adjusted (scaled) as needed (Schmid Figure 1, 4), providing Schmid the benefit of a standard presentation of information for defining fax documents.

Claim Rejections - 35 USC § 103

15. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a w(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this hole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

16. Claims 1-37 are rejected under 35 U.S.C. 103(a) as being unpatentable over Schmid et al. (hereinafter Schmid), U.S. Patent No. 5,659,164 issued August 1997, in view of Ogura (hereinafter Ogura), U.S. Patent No. 5,019,916 issued May 1991.

In regard to independent claim 1, Schmid teaches an electronic facsimile method comprising scanning a document, and electronically transmitting said document along with page specific information, said document and page information temporarily (inherently) stored in memory in an intermediate format (i.e. digital data stored in RAM memory) prior to, and during transmission of information (Schmid Abstract, column 2 lines 4-23, 27-33, 40-45, 57-61, column 4 lines 57-67; compare with claim 1 "*An information processing system....said system comprising:*", and "*temporary storing means for temporarily storing, on a storage medium, output image data composed of a plurality of pages as well as output configuring information;*").

Schmid teaches storing page size information on a cover page of a document, said information used for ascertaining final page size (Schmid column 4 lines 57-67, Figure 4; compare with claim 1 "*acquisition means for acquiring output size of a prescribed page....by said temporary storing means;*").

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Schmid does not specifically teach changing the size of each page based upon the output size. However, Ogura teaches electronic facsimile transmission whereby a transmitting station is notified of a receiving station's paper size. If said receiving station's paper size differs from the fax size, then the transmitting station enlarges/reduces the fax size accordingly prior to transmission, so as to fit the receiving station's paper size (Ogura Abstract, column 10 lines 65-68 to column 11 lines 1-30, especially lines 5-9; compare with claim 1 *"changing means for controlling the size of each page of the output image data based upon the output size acquired by said acquisition means such that all the pages coincide in size with the output size of the prescribed page."*). It would have been obvious to one of ordinary skill in the art at the time of the invention to apply Ogura's image resizing information to Schmid's cover page size information, providing Schmid the benefit of destination page size information, in order to change page size (originally declared by Schmid's cover sheet data) to fit said data, as well as fitting a variety of paper sizes within various facsimile machine brands.

Schmid discloses changing page size of a scanned document accordingly (see above). Since it is well established that scanner/computer/FAX combinations typically comprise the capability of both sending and receiving Fax documents, it is well within reason that a user of Schmid's invention can Fax an already processed (i.e. size altered) electronic document to another receiving computer apparatus. Schmid also teaches network address/destination routing ID (Schmid Abstract, Figure 1, column 4 lines 22-28; compare with claim 1 *"transmitting means for...by said changing means."*).

In reference to the preceding paragraph, Since Schmid acquires initial information from a cover page, FAXing an already processed document to a conventional receiving computer results in said receiving computer ignoring the special information on said cover page, therefore receiving the electronic document pages as is, with output image data processed before the document is FAXed (compare with claim 1 *"wherein said changing means changes the size of the output image data before said transmitting means starts to communicate with the receiving apparatus."*).

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In regard to dependent claim 2, Schmid teaches page size information embedded on a cover page (a leading page of a fax document (Schmid column 4 lines 57-67)).

In regard to dependent claim 3, Schmid does not specifically teach changing the size of each page based upon the output size as specified by the cover sheet data. However, Ogura teaches electronic facsimile transmission whereby a transmitting station is notified of a receiving station's paper size. If said receiving station's paper size differs from the fax size, then the receiving station enlarges/reduces the fax size accordingly prior to transmission, so as to fit the receiving station's paper size (Ogura Abstract, column 10 lines 65-68 to column 11 lines 1-30, Figure 1, 4) It would have been obvious to one of ordinary skill in the art at the time of the invention to apply Ogura to Schmid, providing Schmid the benefit of destination page size information, in order to temporarily modify Schmid's cover sheet page size content information, so as to fit a variety of paper sizes within various facsimile machine brands.

In regard to dependent claim 4, Schmid does not specifically teach changing the size of each page based upon the output size as specified by the cover sheet data, so as to be identical with output paper size. However, Ogura teaches electronic facsimile transmission whereby a transmitting station is notified of a receiving station's paper size. If said receiving station's paper size differs from the fax size, then the receiving station enlarges/reduces the fax size accordingly prior to transmission, so as to fit the receiving station's paper size (Ogura Abstract, column 10 lines 65-68 to column 11 lines 1-30, Figure 1, 4) It would have been obvious to one of ordinary skill in the art at the time of the invention to apply Ogura to Schmid, providing Schmid the benefit of destination page size information, in order to temporarily modify Schmid's cover sheet page size content information, so as to fit a variety of paper sizes within various facsimile machine brands.

In regard to dependent claims 5, 6, as presented in the rejection of claim 1, above, Schmid (in view of Ogura) teaches enlarging/reducing output page sizes, based upon analysis of Schmid's cover sheet information

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and Ogura's applied teaching of transmitted paper size information. Since a cover sheet is typically part of a transmitted fax document, and since page size modifications apply to a faxed document, said cover sheet is also changed accordingly (see also Schmid column 4 lines 57-67) (compare with claims 5, 6).

In regard to dependent claim 7, Schmid teaches a fax transmission (Schmid column 2 lines 27-34, especially lines 40-44).

In regard to claims 8-14, claims 8-14 reflect the apparatus comprising computer executable instructions used for implementing the system as claimed in claims 1-7, respectively, and are rejected along the same rationale.

In regard to claims 15-21, claims 15-21 reflect the computer executable methods comprising computer executable instructions used for implementing the system as claimed in claims 1-7, respectively, and are rejected along the same rationale.

In regard to claims 22-28, claims 22-28 reflect the computer executable methods comprising computer executable instructions used for implementing the system as claimed in claims 1-7, respectively, and are rejected along the same rationale.

In regard to independent claim 29, claim 29 reflects the computer program product comprising computer executable instructions used for implementing the system as claimed in claim 1, and is rejected along the same rationale.

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In regard to independent claim 30, claim 30 reflects the computer program product comprising computer executable instructions used for implementing the system as claimed in claim 1, and is rejected along the same rationale.

In regard to independent claim 31, claim 31 reflects the apparatus comprising computer executable instructions used for implementing the system as claimed in claim 1, and in further view of the following, is rejected along the same rationale.

Schmid teaches page size information embedded on a cover page (a leading page of a fax document (Schmid column 4 lines 57-67; compare with claim 31 *"to attach cover page information"*)).

In regard to dependent claim 32, claim 32 reflects the apparatus comprising computer executable instructions used for implementing the system as claimed in claim 7, and is rejected along the same rationale (see also Schmid Figure 1, 2A – scanned and OCR'd images of page documents).

In regard to dependent claim 33, claim 33 reflects the apparatus comprising computer executable instructions used for implementing the system as claimed in claim 2, and is rejected along the same rationale.

In regard to dependent claims 34, 35, Schmid does not specifically disclose template information associated with cover page information. However, Schmid teaches an "MRI" comprising a set display of page information, which provides reasonable suggestion to the skilled artisan of an information template, the size of said cover page (with attached MRI) to be adjusted (scaled) as needed (Schmid Figure 1, 4), providing Schmid the benefit of a standard presentation of information for defining fax documents.

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In regard to independent claim 36, claim 36 reflects the computer executable method comprising computer executable instructions used for implementing the system as claimed in claim 1, and in further view of the following, is rejected along the same rationale.

Schmid teaches page size information embedded on a cover page (a leading page of a fax document (Schmid column 4 lines 57-67; compare with claim 36 “*generating cover page information*”).

In regard to independent claim 37, claim 37 reflects the computer program product comprising computer executable instructions used for implementing the system as claimed in claim 1, and in further view of the following, is rejected along the same rationale.

Schmid teaches page size information embedded on a cover page (a leading page of a fax document (Schmid column 4 lines 57-67; compare with claim 37 “*generating cover page information*”).

Response to Arguments

17. Applicant's arguments filed 7/15/2005 have been fully and carefully considered but they are not persuasive.

Applicant's arguments are substantially directed to amended subject matter. Even if it is determined that Applicant's amendment is not new matter (the Office does not admit this), the claimed invention as recited in the independent claims do not preclude the interpretation of resending a Fax document from Schmid which is already resized, etc. by Schmid. A typical (conventional) Fax computer on a receiving end would simply ignore the cover page data and accept the previously resized document. Please note two separate rejections are applied, based upon two interpretations of the instant claims.

Conclusion

18. Any inquiry concerning this communication or earlier communications from the examiner should be directed to William L. Bashore whose telephone number is (571) 272-4088. The examiner can normally be reached on 11:30am - 8:00pm EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Heather Herndon can be reached on (571) 272-4136. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

19. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

William L Bashore

**WILLIAM BASHORE
PRIMARY EXAMINER**

October 25, 2005